

II. Information Disclosure Statement

The enclosed information disclosure statement comprises the cited documents of the Japanese and European examinations.

III. Rejections Under 35 U.S.C. § 103(a)

The Examiner rejects claims 30-46 under 35 U.S.C. §103(a) over Tomura et al. (U.S. 6,207,719) in view of Lim et al. (U.S. 6,045,590), for the reasons set forth on pages 2-4 of the Office Action. Applicants respectfully traverse the rejection because, at the very least, there is no motivation to combine the references and, further, there is no evidence of a reasonable expectation of success even if the references were combined.

In order to establish a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. See M.P.E.P. § 2143. The Federal Circuit has emphasized the Office's high burden for establishing a *prima facie* case of obviousness and the requirement for specificity in the evidence necessary to support a *prima facie* case. For example, in *In re Lee*, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." 277 F.3d 1338, 1433 (Fed. Cir. 2002) (emphasis added). See also *In re Dembicza*k, 50 USPQ2d 1614 (Fed. Cir. 1999) (requiring a "clear and particular" suggestion to combine prior art references). The Examiner is further directed to the

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recently revised MPEP 2144.03 (MPEP page 2100-131 to 133, Rev. 1, Feb., 2003), which states that it is "never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based." MPEP 2144.03.E. Rev. 1, Feb., 2003; See *In re Zurko*, 258 F.3d at 1386; *In re Ahlert*, 424 F.2d at 1092.

Here, the presently claimed ready-to-use compositions for oxidation dyeing comprise at least one 2-electron oxidoreductase enzyme and its donor, at least one anionic surfactant chosen from eight specific categories as claimed, and at least one oxidation base. The Examiner admits that Tomura fails to teach the presently claimed anionic surfactants but relies on Lim's teaching of hair dyeing compositions comprising these anionic surfactants to remedy Tomura's deficiencies. See Office Action page 3.

Applicants respectfully disagree. Although Tomura may teach anionic surfactants in a list of optional additives, it also clearly states that such additives may be "appropriately added in so far as they do not adversely affect the present invention." Col. 3 lines 50-52. Tomura's invention is an aqueous cosmetic composition containing uric acid in a stably solubilized state together with an acrylic polymer and an alkali to adjust pH. Thus, any additives in Tomura must be chosen very carefully so as not to disturb this stable balance.

Unlike Tomura, Lim neither teaches nor suggests uric acid or oxidative enzymes or acrylic polymers. Thus, even though the Examiner asserts Tomura's general teaching of anionic surfactants, there could hardly have been a reasonable expectation of success in taking a surfactant from Lim, which has nothing in common with Tomura other than being an oxidative hair dye composition, and putting it in the very sensitive

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composition of Tomura. Further, given the known sensitivities of enzymatic activity due to small-molecule allosteric effects (e.g., from surfactants) and Tomura's admonition that surfactants only be added "in so far as they do not adversely affect" enzyme activity of the dye solution, there is no motivation in either reference for one of ordinary skill in the art to combine Lim's anionic surfactants with Tomura's stabilized enzyme solution. The Examiner's assertions of expecting "similar properties" (1) simply do not cure the absent motivation, and (2) do not meet the criteria for relying on facts unsupported by documentary evidence as set forth in the recently revised MPEP 2144.03. (MPEP 2144.03 Rev. 1, Feb. 2003)

More specifically, Lim lists the claimed surfactants in a laundry list of twenty three surfactants, only two of which fall within the scope of the present claims and the Examiner has not provided any reason as to why one of ordinary skill in the art would choose any one particular surfactant out of those listed. In general, a convincing line of reasoning must be presented as to why a skilled artisan would pick and choose various elements and/or concepts from the prior art to arrive at the claimed invention. *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985); *In re Wesslau*, 147 USPQ 391 (Bd. Pat. App. & Inter. 1965); MPEP 2144. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); MPEP 2141.02. Here, there is no line of reasoning presented by the Examiner and considering the teachings of the references themselves, as discussed above, the references do not speak to choosing the claimed surfactants.

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At best, the Examiner provides a list of surfactants from Lim that would be, *arguendo*, obvious to try, with another hair dye system. As the Examiner knows, however, “obvious to try” is not the standard for an obviousness rejection. The Federal Circuit has long held that choosing among a varying range of possibilities presented in the prior art, where the prior art had no indication or direction of a successful result within that range, is not obvious. *In re O’Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988); MPEP 2145 X.B. Here, neither the Examiner, Lim, nor Tomura show any direction or indication as to which of Lim’s twenty three surfactants should be chosen. Thus, one of ordinary skill in the art would not have found the combination of Lim’s surfactants with Tomura’s enzyme solution obvious, even if they would have found it obvious to try (which Applicants do not concede either).

Finally, Tomura teaches away from adding random surfactants because, as noted above, it states that surfactants can be added only “in so far as they do not adversely affect the present invention.” Col. 1, lines 51-53. In general, references may not be combined where the references themselves teach away from their combination. MPEP 2145 X.D.2; *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1983). Here, there is simply no teaching in either Tomura or Lim that allows for the addition of the claimed surfactants while maintaining Tomura’s stated goal of maintaining uric acid solubilization using a combination of certain ingredients. Accordingly, unless the Examiner can point to specific motivation for adding one the eight claimed types of surfactants while maintaining uric acid solubilization, i.e., “clear and particular evidence,” no *prima facie* case of obviousness can be established.

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In light of the above, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

IV. CONCLUSION

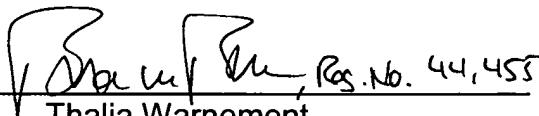
In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 18, 2003

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